

REMARKS

Claims 1-8, 10-13, 15-16 and 18-19 are pending. By this Amendment, claims 1, 2, 7, 10, 11-13, 15 and 18 are amended, claims 6, 9, 14 and 17 are canceled without prejudice or disclaimer, and claim 19 is added. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

Applicant thanks Examiner Hsieh for the courtesies extended to Applicant and Applicant's representative during the February 22, 2005 personal interview. During the interview, it was agreed that the amendments to claims 1 and 10, specifying that the front portion of the cover is between a stringed instrument body and a string of the stringed instrument body, would overcome the current rejections with respect to those claims. No agreement was reached with respect to claim 18, in which Applicant proposed to include the limitation of a "stretchable material." However, Applicant has now added an additional limitation to claim 18, which was not discussed during the interview, and believes that, for the reasons explained in detail below, the combination of features recited in claim 18 is also patentably distinct from the applied prior art.

I. Formal Matters

The Office Action objects to claims 9 and 17. The cancellation of claims 9 and 17 obviates this objection.

II. The Claims Define Patentable Subject Matter

A. The Office Action rejects claims 1-2, 6-10 and 14-18 under 35 U.S.C. §102(b) over U.S. Patent No. 4,000,678 to Messina. This rejection is respectfully traversed.

As discussed and agreed during the interview, claims 1 and 10 are patentably distinct from Messina at least for the recitation of the front portion being between (a) a stringed instrument body and (b) a string of the stringed instrument body.

Claim 18 is patentably distinct from Messina at least for its recitation of a stretchable material. Accordingly, withdrawal of this rejection is respectfully requested.

Although the §102 rejection of claim 18 is obviated by the "stretchable material" limitation, the Examiner indicated that claim 18 would likely be rejected over Messina in view of U.S. Patent No. 3,877,501 to Toth, which discloses stretchable material (latex) in the context of a stringed instrument cover. To better respond to such a rejection, claim 18 has been further amended to recite "wherein the means for attaching is functionally independent of a stretching action of the stretchable material." An example of this feature may be seen in the disclosed embodiments of this application, in which a zipper is used as a means for attaching.

In contrast, Toth discloses a stretchable material (latex) only in a context in which the jacket is to be attached to a stringed instrument by stretching over and engaging with the ears of the stringed instrument (see Fig. 4 and column 2, lines 17-30). Thus, Toth does not disclose means for attaching that is functionally independent of a stretching action of a stretchable material; to the contrary, according to the teaching of Toth, the stretching action is the "means for attaching."

In MPEP §2141.02, the section entitled "PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS," it is made clear that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (emphasis in original). When one considers the Toth reference as a whole, it is clear that Toth discloses a stretchable material only when the stretch function is to serve as means for attachment by allowing the jacket to stretch over and engage the ears of the stringed instrument.

Therefore, starting with the Messina patent as a base reference, the most that one of ordinary skill in the art may have learned from Toth regarding use of a stretchable material is that stretchable material could be used to replace the zipper of Messina. In other words, the combination of Messina and Toth, at most, may have disclosed that either (1) a zipper is used, with non-stretchable fabric; or (2) stretchable material is used, without a zipper, and the jacket is stretched over the ears of the guitar of Messina. In the first scenario, stretchable material is not present, and therefore claim 18 would not have been rendered obvious; in the second scenario, the "means for attaching" is not independent of the stretching action of the stretchable material, and therefore claim 18 would not have been rendered obvious.

Accordingly, claim 18 is patentably distinct even from the combination of Messina and Toth.

B. The Office Action rejects claims 3 and 11 under 35 U.S.C. §103(a) over Messina in view of U.S. Patent No. 6,576,823 to Wise, Jr. ("Wise"). This rejection is respectfully traversed.

Wise, cited for a teaching of neoprene, fails to overcome the above-noted deficiencies of Messina with respect to claims 1 and 10. Therefore, claims 3 and 11 are allowable at least for their dependence on claims 1 and 10, respectively. Withdrawal of this rejection is respectfully requested.

C. The Office Action rejects claims 4 and 12 under 35 U.S.C. §103(a) over Messina in view of U.S. Patent No. 5,763,796 to Britto et al. ("Britto"). This rejection is respectfully traversed.

Britto, cited for a teaching of spandex material, does not overcome the above-noted deficiencies of Messina with respect to claims 1 and 10. Therefore, claims 4 and 12 are allowable at least for their dependence on claims 1 and 10, respectively. Withdrawal of this rejection is respectfully requested.

D. The Office Action rejects claims 5 and 13 under 35 U.S.C. §103(a) over Messina in view of U.S. Patent No. 3,877,501 to Toth. This rejection is respectfully traversed.

Toth, cited for a teaching of latex material, does not overcome the above-noted deficiencies of Messina with respect to claims 1 and 10. Therefore, claims 5 and 13 are allowable at least for their dependence on an allowable base claim. Withdrawal of this rejection is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

J. Adam Neff
Registration No. 41,218

JAO:JAN/scg

Date: March 28, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--